

REMARKS

Claims 1-67 are pending in the above-referenced application. Examiner has required Applicant to elect one of groups I-XXXVII in the Office Action under 35 U.S.C. §121. Accordingly, Applicant hereby provisionally elects, with traverse, Group I, encompassing claims 1-11, 19 and 53, drawn to SEQ ID NO: 1.

I. Traversal

Applicants initially point out that Examiner's requirement for restriction creates 37 separate invention groupings out of only 67 claims. On average, that's less than 2 claims per invention grouping. In reality, Examiner's requirement is even more restrictive, often requiring multiple restrictions from a single claim. Claim 56, for example, is restricted into 5 separate invention groupings.

In this regard, Applicant respectfully submits that examination of all pending claims 1-67 of the present application is far less burdensome for both Applicant and Examiner than would be prosecution of 37 separately filed applications now required as a result of Examiner's restriction.

At a minimum, Applicant respectfully requests that Examiner consolidate the numerous groupings sharing the same classification, particularly those sharing both the same class and subclass. Applicant respectfully submits that such consolidation will impose no serious burden on examination, nor has Examiner alleged that such a burden exists as required under the rules.

A. Common Groupings.

Examiner's groupings sharing the same class and subclass are as follows:

- (1) Groups I-V classified in class 435, subclass 199;
- (2) Groups VI-X classified in class 536, subclass 23.2;
- (3) Groups XI-XV classified in class 800, subclass 8;
- (4) Groups XVI-XX, and XXXI-XXXV classified in class 435, subclass 19; and
- (5) Groups XXI-XXX are classified in class 435 subclass 6.

**B. Examiner May Consolidate These Groupings
In Accordance With The Rules**

The criteria for restriction is set forth in section 803 of the MPEP as follows:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct; and*
- (B) There must be a serious burden on the examiner if restriction is required. (emphasis added) (internal citations omitted).*

Concerning the second prong, § 803 instructs that examiners establish a “serious burden” by demonstrating one of three *prima facie* elements:

- (A) the inventions have a separate classification;
- (B) the inventions have a separate status in the art; or,
- (C) the inventions have a different field of search, as defined in MPEP § 808.02.

**C. Examiner Does Not Allege That Examination Of Claims Sharing The
Same Classification Would Impose A Serious Burden.**

Though Examiner arguably satisfies the *prima facie* case with respect to inventions identified as having separate classifications, Examiner passes no judgment on whether examination of inventions sharing the same classification imposes a similar serious burden. Applicant respectfully submits there is none.

Rather, Examiner alleges that the variously defined inventions are “independent” or “distinct” in satisfaction of only the first prong of this two prong test. For example, the identified groupings are described as “unrelated” in paragraph 2, and “distinct” in paragraph 3. However, as § 803 makes clear, independent or distinct inventions must still be examined collectively, i.e., not restricted, unless such examination would impose a serious burden on the examiner.

Even assuming, *arguendo*, that Examiner’s characterization regarding the independence and distinctness of the inventions is correct, Examiner still has not satisfied the second prong of the test under § 803.

Analysis of the “serious burden” prong is found only within paragraph 9 of the Office Action. There, Examiner states that the inventions have acquired a “separate status in the art” (recalling from above that a separate status in the art is one of basis

upon which an examiner may allege a serious burden). However, by Examiner's own admission, this requirement is satisfied only with respect to inventions of different classifications. Paragraph 9 is copied below:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper. (emphasis added).

Thus, Examiner alleges a "serious burden" only with respect to inventions of differing classifications, and to inventions of the same classification. Accordingly, Examiner must rely upon the third prong of the *prima facie* case in order to satisfy the "serious burden" requirement with respect to these inventions.

(i) Different Field of Search

The third prong of the *prima facie* case is a demonstration that the inventions have a "different field of search." A different field of search is found where it is "necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists" (MPEP § 808.02). However, Examiner makes no allegation that a distinct field of search is required in the explanation.

Accordingly, none of the three factors of the *prima facie* case are satisfied with respect to inventions sharing the same classification.

**D. Where There Is No Serious Burden
Examination Of The Entire Case "Must" Occur**

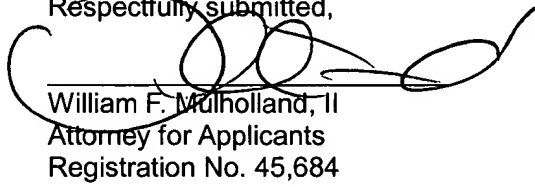
As provided above, Applicant respectfully submits that it is less burdensome to examine at least some of the defined inventions collectively, particularly those sharing the same classification. And Examiner does not allege that so doing, at least with respect to these inventions, imposes any serious burden.

In this particular case, then, the MPEP is clear:

If the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP § 803) (emphasis added).

CONCLUSION

Accordingly, Applicant respectfully requests that Examiner reconsider and withdraw the present restriction, and revise the restriction according to the arguments and suggested groupings presented above.

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